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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,889	03/08/2002	Volkmar Wehner	38005-0164	1149

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EXAMINER

WRIGHT, SONYA N

ART UNIT PAPER NUMBER

1626

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/092,889	WEHNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sonya Wright	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1, 2, 4, and 10-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This is in response to Applicant's amendment filed August 28, 2003. Claims 1, 2, 4, and 6-13 are pending in this application. The restriction requirement has been maintained. The rejection under 35 U.S.C. 112 first and second paragraphs have been overcome with Applicant's amendments.

#### ***Claim Objections***

Claims 1, 2, 4, 10, 11, 12, and 13 are objected to because of the following informalities: Claims 1, 2, 4, 10, 11, 12, and 13 contain subject matter which is withdrawn from consideration. It is suggested that Applicant limit the claims to the generic embodiment that was set forth in the Office Action mailed 2-28-03. Appropriate correction is required.

#### ***Allowable Subject Matter***

Claims 6-9 are allowable over the prior art of record.

#### ***Response to Arguments***

Applicant's arguments filed 2-28-03 have been fully considered and are persuasive with respect to the rejections under 35 U.S.C. 112 first and second paragraphs, but they are not persuasive with respect to the restriction requirement. Applicant argues that it is improper for the Patent Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. Applicant further argues that unity of invention exists and the claims should be examined in their entirety. Applicant argues that because the elected species

apparently were found allowable over the prior art (no prior art is cited in the Office action) the scope of examination should be extended as set forth in MPEP 803.02 and it is improper for the Examiner to "withdraw from consideration" the non-elected subject matter.

However, even though an art rejection has not been made in this application, the requirement for restriction is maintained and the search has not been extended. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) the claimed subject matter accordingly. For example, the claims encompass heteroaryl groups which are variously classified, therefore "heteroaryl" has been restricted out of the generic embodiment identified for examination. The following is an illustration of the varied classification of the heteroaryl groups: pyrazinyl is classified in class 544 and subclass 336+; pyrimidinyl is classified in class 544 and subclass 242+; pyridinyl is classified in class 546 and subclass 268.1+; oxazolyl is classified in class 548 and subclass 215+; thiazolyl is classified in class 548 and subclass 146+; etc. . . Thus, the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. No where to Applicants argue to the contrary. No where do Applicants point out and give reasons why the claims do not involve independent or distinct subject matter.

Accordingly, the restriction is proper. Moreover, it would constitute a burden to extend the search because separate search considerations would be involved in both the U.S. Patents and in the literature. The examination process following the search could easily result in different and thus burdensome considerations.

The restriction requirement here is predicated on the premise that the various compounds involved differ in structure and element so much so as to be patentably distinct, i.e. a reference which anticipated the elected compounds claimed would not even render obvious the others. Again, 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application to a single invention. Applicant has not presented evidence that the examined subject matter is patentably indistinct from the non-examined subject matter. Nor have the even argued to the contrary. Moreover, the sheer number of variables, their huge possibilities, and the almost incomprehensible number of permutations and combinations thereof result in compounds so numerous and diverse so as to be a burden to classify, search, and examine. Accordingly, the requirement to restrict is considered proper and is maintained. The search and examination of the application is directed to the generic embodiment identified for examination only.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Wright, whose telephone number is (703) 308-4539. The examiner can normally be reached on Monday-Friday from 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by

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the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1235.



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Joseph K. McKane

Supervisory Patent Examiner

Group 1600

Sonya Wright

November 13, 2003